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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,995	01/29/2004	Isabel N. Gonzalez		2949

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JAMES C. WRAY
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MCLEAN, VA 22101

EXAMINER

SHIPLEY, AMY R

ART UNIT	PAPER NUMBER
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3734

NOTIFICATION DATE	DELIVERY MODE
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10/18/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jameswray@jcwray.com

Office Action Summary**Application No.**

10/765,995

Applicant(s)

GONZALEZ, ISABEL N.

Examiner

AMY SHIPLEY

Art Unit

3734

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 6-16 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 6-11 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☒ Claim(s) 12-16 are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 26 September 2011 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-GB/US)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

This action is in response to the amendment filed on 9/26/2011. Claims 1-5 are cancelled and claims 6-16 are added.

The changes to the abstract are accepted. The 112 USC § second paragraph rejections are withdrawn as all previous claims have been cancelled.

Drawings

1. The drawings are objected to under 37 CFR 1.84(h)(5) because Figures 1-5 show(s) modified forms of construction in the same view. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Applicant is advised to use 1A, 1B, etc to label separate components.

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because descriptive text is not permitted in drawings. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Election/Restrictions

3. Inventions claims 6-11 nasal device and claims 12-16 method of using a nasal device are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the device can be placed about the nostrils whereas the method indicates the plastic covers are placed within the nasal passage.

4. Newly submitted claims 12-16 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the device can be used in a materially different process.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorner (USP 6,238,411).

With regards to claim 6, Thorner discloses a nasal device with a first plastic cover (3) (left of figure 1), a metal wire (1) (column 7 lines 7-10) connecting the first plastic cover to a second plastic cover (3) (right of figure 1), an adhesive strip (5) placed on the surface of the device configured to adhere the device to the nasal lobe of a user, the metal wire configured to confirm to a nostril of a user's nose, and the adhesive strip is about a half inch in length (column 10 lines 9-10).

Thorner does not specifically indicate the metal wire having a length of about 1 inch in length, however does indicate that element 18 as shown in figure 10 is about $2\frac{1}{2} - 2\frac{7}{8}$ inches long. Element 18 is longer than element 1 thus it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Thorner's metal wire with a length of about one inch in length. Furthermore, as indicated (column 8 lines 23-37), the device is sized as to fit the user thus it would have been obvious to one of ordinary skill in the art at the time of the invention to size wire 1 in such a way as to fit the specific nose of a patient, including 1 inch in length.

7. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorner (USP 6,238,411) in view of Rimkus (USP 5,890,491).

With regards to claim 7, Thorner fails to disclose placing adhesive strips on the plastic covers. Rimkus teaches an intranasal device with adhesive located upon the device; upon the portion placed within the nostril as shown in figure 3 element 18. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Thorner to include an adhesive strip (column 4 line 34-36) upon the portion of the device placed within the nostril as taught by Rimkus as to secure the device within the nostril.

With regards to claims 8 and 9, the claimed phrase "the metal wire is curved with a transformer to conform the shape" is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are not limited to the

manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. MPEP 2113. Like applicant, Thorner discloses a device configured to conform to the shape of the nose.

With regards to claims 10 and 11, which are dependent upon claims 8 and 9 which as indicated above are being treated as a product by process limitation. Thorner discloses a device with plastic balls (3) on the end (column 6 lines 54-56 and 63-65).

Response to Arguments

8. Applicant has cancelled all previously pending claims thus there are not any arguments with regards to the previous office action
9. Applicant's newly presented claims are addressed above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Land et al (USP 6,701,924.
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Amy Shipley whose telephone number is (571)270-5500. The examiner can normally be reached on 8:30-5pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, SPE Gary Jackson, at (571) 272-4697.*** The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to TC3700_Workgroup_D_Inquiries@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy Shipley
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10/11/2011

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